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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91201920
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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CITIGROUP INC.,	:	
	:	
Opposer,	:	
- against -	:	Opposition No. 91201920
	:	
CITIAIR, LLC,	:	
	:	
Applicant.	:	
	:	
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TRIAL BRIEF OF OPPOSER CITIGROUP INC.

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Citigroup Inc. ("Citigroup" or "Opposer") respectfully submits its brief in support of its opposition to the registration of the mark CITIAIR (and Design), shown in U.S. Trademark Application Serial No. 85/219,849 (the "Citiair Application," or the "Application"), filed by Citiair, LLC ("Applicant").¹

PRELIMINARY STATEMENT

Applicant Citiair, LLC is a New York-based travel agency founded in 2009. Its business almost exclusively is booking air travel to and from India. This opposition proceeding (the "Opposition") became necessary when Applicant applied to obtain a registration for CITIAIR, along with an airplane design, for "Travel booking agencies":



The applied-for services are highly similar, if not identical, to certain of the services provided by Opposer under its extremely well-known CITI mark and family of CITI-prefixed marks.

Citigroup owns the "iconic" service mark CITI for financial and related services, including credit card services and loyalty rewards programs. Said mark has been one of the most well-known financial services marks in the United States for two decades or more. The fame of the CITI mark, and that of a family of CITI-prefixed marks, has been recognized in a number of federal court decisions. See, e.g., CIT Grp., Inc. v. Citicorp, 20 F. Supp. 2d 775, 793 (D.N.J. 1998) (CITI marks, "through extensive use and advertising have become internationally famous"). Opposer's extensive family of CITI Marks consists of both marks that are registered (e.g., CITITRAVEL, CITIDIRECT, CITI THANKYOU) and those that are unregistered (e.g., CITI CARDS) (collectively, the "CITI Marks").

¹ A list of all of the witnesses is provided in the Statement of Facts. "Citi Ex." refers to an exhibit offered by Opposer (Citi Ex. 1 – Citi Ex. 188). "App Ex." refers to one of Applicant's exhibits (App Ex. 1 – App Ex. 8). Exhibits from Opposer's Notice of Reliance are referred to as "NOR Ex." (NOR Ex. 501-NOR Ex. 801).

For decades, in addition to its extensive financial services, Opposer has at various times offered travel-related services, including travelers checks, a robust credit card program, and loyalty rewards and discount programs to incentivize cardholder membership and use. A primary, if not the most significant, aspect of the loyalty rewards offered by Opposer to its cardholders is travel rewards, and specifically air travel rewards. These services, typified by programs such as the CitiTravel program, the Citi AAdvantage program, and the Citi ThankYou program, provide on an annual basis *****² of dollars' worth of air travel to millions of Opposer's customers.

In view of the foregoing, even Applicant's current limited use of the CITIAIR mark is highly likely to cause confusion among consumers, given the striking mark similarities (because they both use "CITI" as the central and dominant characteristic) and the closely related, if not identical, service offerings (air travel bookings). While Applicant currently promotes its services to a narrow segment of the population (persons of Indian descent residing in the United States), Opposer has a comprehensive program of promoting specialized financial services to the same market segment, defined legally by the Government of India as "Non-Resident Indians," or "NRIs." Furthermore, if sanctioned by a federal registration, Applicant would be free to (and actually intends to) greatly expand its usage of the applied-for mark, making service mark confusion even more inevitable.

The DuPont factors most significant here – strength of the CITI Marks, similarity of the parties' marks, and similarity of the services offered by the parties, overwhelmingly support Opposer. See In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Moreover, none of the other factors weigh in Applicant's favor, as the following brief summary shows:

- **Strength/fame of the CITI Marks**

There can be little argument that the CITI Marks are famous. The evidence on this point includes both sponsored and independently conducted brand strength surveys showing total awareness levels among United States consumers, over more than a 20-year period, in the ***** percent range or even

² Throughout, asterisks indicate confidential material which has been redacted.

higher, in addition to enormous revenues and ***** spent annually on advertising. As an extremely strong family, the CITI Marks are entitled to the broadest scope of trademark protection, as well as protection against usages that could dilute Opposer's goodwill.

- **Similarity of the Marks**

The marks are strikingly similar, as CITIAIR contains the same "CITI" prefix as Opposer's extensive family of CITI Marks. "CITI" is the dominant portion of Applicant's mark, given both that it is the first term in the mark, and that the second term ("AIR") is merely descriptive of the services provided. Nor does the airplane design, as a generic or descriptive visual, advance Applicant's position. Not surprisingly, airplane logos have been used by Citigroup as visual elements alongside a number of the CITI Marks, including in connection with Opposer's travel-related promotional materials.

- **Similarity of Services**

The Application cites "travel booking agencies" services. Such services have been provided by Opposer for many years in various ways under the family of CITI Marks, including but not limited to loyalty rewards programs in support of its credit card offerings. Specifically, the services actually offered by Applicant (i.e. airfare bookings) are provided by Opposer under these programs. Thus, Applicant's services are, for all material purposes, either identical to services Opposer has and is offering, or extremely closely related.

- **Channels of Trade**

Applicant's target demographic in the United States is persons of Indian descent who desire to travel inexpensively to India. Opposer's Non-Resident Indian program basically targets the exact same demographic, providing NRIs living in the United States a wide array of services, including credit cards and the appurtenant loyalty programs. While Applicant's business is currently conducted exclusively online (using "CITI"-branded websites) and over the telephone (using a "CITI" vanity telephone number), this is not a distinguishing factor because Opposer relies heavily on websites, as well as "vanity" toll-free numbers.

- **Actual Confusion/Concurrent Use of the Marks**

Citigroup acknowledges the absence of evidence of actual confusion between its CITI Marks and Applicant's mark. That is neither surprising nor significant, given Applicant's limited use to date. Applicant has, however, stated its intention to open a number of bricks-and-mortar locations nationwide, all to be located in the same geographic areas in which Opposer conducts its NRI business under the CITI Marks, and where Opposer's financial centers are concentrated. In any event, it is unlikely that evidence of actual confusion would come to the attention of Opposer.

- **Third party uses of CITI Marks for Similar Goods**

Applicant has not offered any evidence that any third parties use the term "CITI" for the types of services at issue here, or that there are any federal registrations for such marks. In addition, Opposer has documented in the record its comprehensive policing efforts over the past several decades to protect the goodwill in the CITI Marks, especially Opposer's policing of the federal register.

* * *

In sum, the evidence supporting Opposer's showing of trademark infringement (and dilution as well), is overwhelming, and the pending Application should be rejected.

STATEMENT OF FACTS

A. Prior History of this Proceeding

On January 18, 2011, Applicant filed an application to register CITIAIR and Design, U.S. Ser. No. 85/219,849. (NOR Ex. 566.) Opposer timely filed a Notice of Opposition on October 5, 2011 (Docket No. 1), amended on November 22, 2011 (NOR Ex. 567, Docket No. 5).

One discovery deposition was taken (that of Prakash Raj, founder of Applicant), as well as seven testimony depositions (the first six on behalf of Opposer):

- | | | |
|----|---------------------|--|
| 1. | Anne Moses, Esq. | Associate General Counsel, Citigroup (10/15/12) |
| 2. | Anthony Michelini | Director, Global Branding, Citigroup (10/16/12) |
| 3. | Mary Ann Villanueva | Director, Global Branding, Citigroup (10/16/12) |
| 4. | Asieh Nariman, Esq. | Vice President, Senior Counsel, Citigroup (10/16/12) |
| 5. | Mary Hines | Director, Head of ThankYou Rewards, Citigroup (10/23/12) |
| 6. | Jason Baum | Director, Head of Co-brand Acquisitions (10/23/12) |
| 7. | Prakash Raj | Founder, Citiair, LLC (12/13/12) |

B. Applicant Citiair, LLC

Applicant is located near Albany, New York. (See App Ex. 1, at 7.) Applicant offers "travel booking agencies" services, almost exclusively air travel to and from India. (Raj Tr. at 24:7-15.) In 1998, while Applicant's founder, Prakash Raj, lived in Singapore (Raj Tr. at 8:8-20), he was a co-founder of Citiair Singapore, whose primary purpose was to sell affordable tickets between Singapore and India. (Raj Tr. at 10:6-11:24.) Mr. Raj claims that the term "Citi" was selected to evoke "enlightenment" in his native language (Raj. Tr. at 13:6-14:7),³ while the term "Air" was a "natural fit" since the company sold air services. (Raj Tr. at 13:6-14:11.)

In 2009, Mr. Raj, who had relocated to the United States, formed Applicant Citiair, LLC. (Raj Tr. at 16:4-7.) No investigation was done to confirm whether the applied-for trademark was available for use by the new company. (NOR Ex. 605, at 20:8-13.) In June 2009, Applicant began to offer travel services under the mark CITIAIR in the United States. (Raj Tr. at 18:12-17.) Primarily, Applicant

³ It is not clear on this record that this transliteration is correct (see Nariman Tr. at 35:17-36:20), or that "CITY," or "SITI," or "SITY," would not have served this alleged purpose as well as CITI. (Id.)

offered air travel tickets between India and the United States. (Raj Tr. at 18:18-19:4), mostly for "Indian customers." (Raj Tr. at 17:18-18:3.)

Initially, these services were primarily offered via a toll-free number which customers could call to reach Applicant's Indian outsourcing office. (Raj Tr. at 19:5-12, 28:9-25.) That toll-free number, (888) 248-4697, was, and continues to be, promoted by Applicant as (888) CITI-697. (NOR Ex. 605, at 37:3-19 & 66:18-67:20; App Ex. 1, at 7.) The airplane logo, as currently depicted in the Application, was designed in 2010, and was created to "show[s Applicant] sell[s] air tickets." (Raj Tr. at 21:3-22:6; see also NOR Ex. 605, at 82:15-21 ("We book airline tickets, so that's what we came [up] with.")) The company name, CITIAIR, is occasionally used without the logo. (Raj Tr. at 63:8-12.)

Currently, "99.9 percent" of Applicant's business is selling air tickets between the United States and India. (Raj Tr. at 24:7-15.) Applicant's remaining business mostly consists of selling local tickets within India. (NOR Ex. 605 at 25:15-20.) Despite advertising that it sells cruise packages, travel insurance, and hotel reservations, it apparently does not provide such services to any non-trivial degree. (NOR Ex. 605, at 27:19-28:8.) Since July 2012, Applicant's customers have been able to book their travel online through a booking engine on one of Applicant's websites, citiairtravel.com. (Raj Tr. at 29:20-30:9.) (Applicant also maintains several other websites, all including the mark "CITIAIR" in the domain name, see, e.g., NOR Exs. 572-574; App Exs. 9, 10, 12, 13.) ***** of Applicant's customers pay for its services with credit cards. (NOR Ex. 605, at 41:15-18.)

Marketing efforts at the time of Citiair's founding focused on distributing business cards in retail outlets frequented by Indian nationals and regional Indian festivals. (Raj Tr. at 19:13-20:5.) Currently, Applicant also conducts internet advertising, including disseminating small banner advertisements and listing services on Indian language websites such as sulekha.com and eknazar.com. (Raj. Tr. at 22:25-23:20, 26:5-27:12.) Mr. Raj attends a small number of Indian cultural festivals in the Northeast, including in Boston, Albany, and New Jersey, procuring a small booth to distribute business cards. (Raj Tr. at 35:7-36:5, 37:6-22.) Applicant also sends email blasts weekly to its customers. (Raj Tr. at 40:5-19.) Overall, Applicant spends roughly \$***** a year on marketing. (Raj Tr. at 44:23-45:8.)

Applicant's primary demographic in the United States consists of Indian nationals residing in the

***** (Raj Tr. at 42:2-17.) Applicant's principal competitors are
***** (Raj Tr. at 43:8-16.) Applicant's revenues
***** (Raj Tr. Ex. 6.)
Though Applicant currently has no bricks and mortar locations, in the near future it plans to open several
such locations throughout the United States, including in
***** (NOR Ex. 605, at 26:10-27:18.)

C. The Application at Issue

Applicant is the current owner of the pending federal trademark application for CITIAIR (and Design), U.S. Ser. No. 85/219,849, consisting of the word CITIAIR and an airplane design. In that Application, Applicant cites "travel booking agencies" as the service provided under the applied-for mark, and claims a first use date of March 31, 2009. Citigroup promptly filed a Notice of Opposition when it learned of the pending Application, and on November 22, 2011 filed an Amended Notice of Opposition.

D. Opposer Citigroup

Opposer Citigroup is a world-renowned financial services company.⁴ Through its subsidiaries, affiliates, and divisions, including Citibank, N.A. ("Citibank"), Opposer provides a broad range of financial and related services to consumers and corporate customers, including traditional commercial banking services such as checking accounts, savings accounts, loans, mortgages, and credit and debit cards (Citi Ex. 183 ¶ 9), as well as appurtenant services such as loyalty rewards programs and other consumer lifestyle-related services (Hines Tr. at 7:23-8:12).

⁴ Unless the context indicates otherwise, references to "Citigroup" or "Opposer" include predecessor entities.

1. History of Opposer

Opposer was originally chartered on June 16, 1812 under the banking laws of New York State as the "City Bank of New York."⁵ In July 1865, Opposer converted its state charter to a national charter and changed its name to the National City Bank of New York. By 1912, it was not only the largest commercial lender to New York City businesses, but over 400 foreign banks maintained accounts with it. By the end of 1967, Opposer had become the largest United States banking presence in the world, having 208 foreign branches in 61 countries. (Citi Ex. 183 ¶¶ 15-19.)

Following World War II, governmental regulations which had historically prohibited geographic bank expansion became less restrictive. To take advantage of the opportunities this created, Citibank formed a new holding company (whose name was changed to "Citicorp" in 1974) to serve as a vehicle for expansion. (Citi Ex. 183 ¶¶ 21-23.) Starting in the late 1970s, Opposer introduced and heavily promoted its automated Citicard Banking Centers ("ATM machines," or "ATMs"), thus earning for itself a reputation as a technological pioneer in the banking industry. (Moses Tr. at 15:5-16:6.) In addition, during that period of time Opposer issued millions of credit cards, prominently bearing the mark CITIBANK, and sent millions of solicitations in the mail supporting that business on an annual basis. (Citi Ex. 183 ¶ 23.)

The expansion in branches, national travelers check program and hugely successful credit card business gave consumers considerable exposure to both the CITIBANK and CITICORP (and other CITI) marks. By the 1970s, Citibank was the second largest bank in the world. By 1983, its consumer loan portfolio was \$29 billion, with 90 percent of consumer earnings being generated outside New York. (Citi Ex. 183 ¶¶ 24-25.) By 1984, Citibank and Citicorp had customers in every state and relationships with 11.7 million domestic households, i.e., one of out of every seven U.S. households. (Id. ¶ 26.)

Citigroup Inc. was formed in October, 1998 following the business combination of Travelers Group Inc. and Citicorp. (Moses Tr. at 16:7-14.)

⁵ Opposer's historical facts are set forth in the testimony of Anne Moses, at 13:24-16:14.

2. The CITI Family of Marks

Opposer's first documented use of a "CITI"-prefixed mark was of the term "Citibank" in 1897, as the bank's cable address. (Moses Tr. at 16:15-17:13; Citi Ex. 186.) On January 19, 1960, Opposer obtained a federal registration for the mark CITIBANK for banking services (U.S. Reg. No. 691,815). (NOR Ex. 581.) Other key early CITI Marks used and owned by Opposer in the years following the registration for CITIBANK included CITICORP, THE CITI NEVER SLEEPS, CITICARD and CITI. (Moses Tr. at 18:13-19:8, 20:10-25, 22:15-23:2.)

In 1981, Opposer obtained a federal registration for the mark CITI for a wide variety of services (U.S. Reg. 1,181,467). (NOR Ex. 582.) Several years following the 1998 business combination of Travelers Group Inc. and Citicorp, Citigroup's master brand began transitioning towards "CITI." (Moses Tr. at 20:10-20:24; see also Michelini Tr. at 7:1-4, 16:4-8.) Today, the mark CITI is without doubt the "master brand for the organization, meaning that everything we do as a company is under the [CITI] name." (Villanueva Tr. at 7:9-22; see also id. at 19:22-20:11.)

At any given point during the past 20 years, there have been dozens of federally registered marks in the CITI family, with numerous others protected by common law rights. (Moses Tr. at 56:12-20.) Opposer's registered (and currently subsisting) marks include: CITIBANK, U.S. Reg. No. 691,815; CITIGROUP, U.S. Reg. No. 2,406,753; CITIDIRECT, U.S. Reg. No. 2,261,522; CITI NEVER SLEEPS, U.S. Reg. 1,104,470; and CITITRAVEL, U.S. Reg. No. 2,954,363. (See NOR Ex. 567, Amended Notice of Opposition Ex. A (Docket No. 5); Moses Tr. at 21:4-23:23.) In Citigroup's Amended Notice of Opposition, for instance, Opposer identified 24 currently registered CITI Marks, as well as four historical prominent registered names which were used for many years before being cancelled. (See NOR Ex. 567, Amended Notice of Opposition Ex. A. (Docket No. 5).)

It goes without saying that the CITI brand and trademarks are extremely important to Opposer. (Villanueva Tr. at 21:13-16.) Given that Opposer's branding strategy was focused on using the famous CITI component, which was already registered, Opposer concluded that registration was no longer necessary for all new CITI mark combinations. (See Moses Tr. at 55:16-56:5; Villanueva Tr. at 7:19-22.)

Thus, Citigroup also offers financial and related services under many CITI Marks which are not registered, including CITI CARDS and CITI DIVIDEND. (Moses Tr. at 23:24-26:16; NOR Ex. 567, Amended Notice of Opposition Ex. B (Docket No. 5).)

For decades, Opposer has employed its CITI Marks as a family of marks, in the sense that the "master" mark CITI or another key family mark (e.g., CITIBANK) is used along with one or more CITI Marks in association with each other. (See Citi Exs. 36, 37, 39; Moses Tr. at 26:17-41:22; Villanueva Tr. at 8:16-9:14, 19:22-20:11.) Instances of such family usage pervade Opposer's promotional materials, and include the following as representative examples:

- As early as the 1970s, radio advertisements promoting Citicard Banking Centers used the marks CITIBANK, CITICARD, and THE CITI NEVER SLEEPS in a single ad. (Citi Ex. 39, at OPP005561.)
- A brochure from the 1990s promoting Opposer's CitiGold program used the marks CITICORP, CITIGOLD, CITIBANK, CITICARD, and THE CITI NEVER SLEEPS on the front page alone, and continued to use several other CITI Marks throughout. (Citi Ex. 39, at OPP001882-9.)
- A 1990s print advertisement not only used the marks CITIBANK, THE CITI NEVER SLEEPS, and CITICORP INVESTMENT SERVICES, but also invited consumers to purchase the proffered services using a CITI vanity telephone number. (Citi Ex. 39, at OPP004959.)
- As of 2008, Opposer's commercial cards website used the marks CITI (both with and without design), CITIBANK COMMERCIAL CARDS, CITIGROUP, CITIMANAGER, and CITIDIRECT, among others. (Citi Ex. 36.)
- Citigroup's credit cards website, as of 2012, included the marks CITI, CITI THANKYOU, CITI PLATINUM SELECT/AADVANTAGE, CITI DIAMOND PREFERRED CARD, CITI PRIVATE PASS, and CITI TABLET APPS. (Citi Ex. 43.)

Because of the strong association in the minds of consumers between the mark CITI and the products and services of Opposer, Citigroup has long owned a number of "vanity" telephone numbers incorporating the term "CITI," through which consumers may communicate with Opposer. (Moses Tr. at 25:10-26:16, 86:25-87:8; see NOR Ex. 567, Amended Notice of Opposition Ex. B (Docket No. 5).) Several of these telephone numbers are federally registered. (Moses Tr. at 25:2-9.)

Several design elements have been used at various times over the decades with one or more of the CITI Marks. These include the blue wave, compass rose, and red arc. (Moses Tr. at 19:9-20:9.) Currently, as in the past, the CITI Marks are used both with and without these designs. (Moses Tr. at 19:9-20:9; Villanueva Tr. at 20:12-17; see also Citi Ex. 36.)

3. Opposer's Policing of CITI Marks

Citigroup has vigorously policed its CITI Marks. (See Moses Tr. at 70:10-71:19, 80:6-81:12; Citi Ex.183 ¶ 30.) Opposer has, in the United States alone, spent more than \$ ***** over the past twenty years in support of a comprehensive program of policing its CITI Marks. (Id.) In addition to sending and following through on numerous cease and desist letters, on many occasions where necessary Opposer has initiated opposition proceedings in the TTAB, filed lawsuits, or taken other enforcement activities against suspected infringers of the CITI Marks. (Moses Tr. at 71:20-79:14.)

With respect to travel-related services specifically, in the past ten years Citigroup has successfully challenged the registration and/or use of third-party marks incorporating the term CITI for services related to the travel booking agency business. For example, Opposer successfully opposed a trademark registration for the mark CITISTAY for hotel lodging (Citi Ex. 176; Moses Tr. at 73:18-75:5). Moreover, Opposer's lawsuits against potential infringers include those challenging a third party seeking to use a CITI-prefixed mark for travel-related services. (See Moses Tr. at 79:6-14, Citicorp. v. Parvin, No. 05 Civ. 5884 (S.D.N.Y. Complaint filed June 24, 2005), challenging use of CITITRAVEL mark for travel agency services).

4. Services Offered by Opposer Under the CITI Marks

Currently, CITI is Citigroup's "master" brand, and virtually all of Opposer's main businesses are principally (if not solely) branded with one or more of the CITI Marks, or at a minimum reference one or more CITI Marks in the bulk of their collateral materials. (Villanueva Tr. at 7:9-22, 8:16-9:14, 19:22-20:11.) Examples in Opposer's consumer business include retail banking (consisting of more than 4,600 branches across the globe and holding deposits exceeding \$300 billion); CITI branded credit cards (as one of the world's largest credit card issuers); Citi Retail Services (one of the largest providers of consumer and commercial credit card products, services, and retail solutions in the United States, with nearly 90 million accounts); and Citi Commercial Bank (servicing 100,000 small to medium-size companies worldwide). (Citi Ex. 42; see generally Villanueva Tr. at 23:21-24:16.)

(a) Retail Banking Services

Citigroup has long had banking centers (also known as "branches" or "financial centers"), as well as ATM "locations," in markets across the United States. Currently, there are over 1,000 CITI-branded branches in key markets nationwide, including New York, California, Illinois, Texas, Washington, D.C., and Florida. (Villanueva Tr. at 33:11-34:2; Moses Tr. at 97:9-23; NOR Ex. 564, at OPP008482.) In addition, Opposer has thousands of ATM machines nationwide, including a network of approximately 6,000 CITI-branded ATMs in 7-Eleven convenience stores. (Villanueva Tr. at 33:15-34:2.)

(b) Citi Consumer Cards Business

For decades, Opposer has offered to consumers nationwide a number of Citi-branded (and co-branded) credit cards. Opposer's fame was initially established across the United States largely as a result of its credit card business, which was promoted nationally. (Moses Tr. at 44:4-20.) As of December 31, 2011, there were approximately 22 million Citi-branded credit card accounts in North America, more than ***** of which were in the United States. (Moses Tr. at 130:17-131:12; Villanueva Tr. at 28:4-17; NOR Ex. 564, at OPP008482.) All of these credit cards are prominently branded with the mark CITI, and the promotional materials and collateral appurtenant to such cards all contain at least one, and often several, CITI Marks. (Villanueva Tr. 34:3-18; Citi Exs. 43, 44, 46, 49.)

(c) Citi Corporate and Governmental Credit Cards

Opposer offers a number of commercial credit cards, both to corporate and government clients. (Moses Tr. at 62:4-13.) This has been a core business for Opposer for more than *****, and Opposer currently has in excess of ***** commercial clients, with well over ***** commercial cardholders in the United States. (Moses Tr. at 64:2-11, 68:8-11.) The CITI (or occasionally CITIBANK) mark is used on all of the credit cards, as well as on the accompanying customer collateral materials. (Moses Tr. at 62:14-63:8; see Citi Exs. 32, 33, 35-37.) The CITI Marks also appear prominently throughout Opposer's CitiManager website, which provides tools and other resources for the commercial clients of this service. (See Citi Ex. 37; NOR Exs. 544-545.)

Citigroup's corporate cards are issued to a number of the nation's largest companies, including over ***** Fortune 500 customers, such as ***** (Moses Tr. at 64:17-65:2.) Each of these companies, in turn, issues thousands of credit cards to its employees. (Id.) The CITI Marks appear on the credit cards themselves, as well as in the credit card carriers, collateral materials, and online customer website. (Moses Tr. at 62:14-63:8; see generally Citi Exs. 32, 35-37, 66.) One such corporate card issued by Opposer is the Citi Corporate Card for travel and entertainment expenses. (Moses Tr. at 102:21-104:5.)

Similarly, Citigroup has issued government credit cards since 1998, and is currently the largest provider of such cards, issuing millions of credit cards to employees in major government agencies such as the Department of Defense. (Moses Tr. at 66:1-67:3.) The CITI Marks are also present on all of these credit cards, as well as in the accompanying collateral materials and user agreements (Citi Exs. 32, 33), and on the online customer website (Citi Ex. 35).

(d) Use of CITI Marks for Travel-Related Services

Over the past decades, Opposer has offered a number of services appurtenant to its core services, including those directly related to travel. (E.g., Moses Tr. at 82:3-83:5.) In this connection, a key part of Opposer's value proposition to its customers is the attraction of travel and travel-related services. (Villanueva Tr. at 72:19-73:12.) For example, in 1980, Opposer began issuing CITICORP-branded

traveler's checks, specifically intended to be used by its customers for purchases made away from home. (Moses Tr. at 23:3-23.) This was a significant nationwide business for Opposer in the 1980s and 1990s, at some point second only to American Express. (Id.) In addition, as noted, Citigroup subsidiaries have issued millions of credit cards to consumers, corporate clients and governmental agencies nationwide bearing one or more CITI Marks, including specialized travel cards in the consumer and commercial sectors. (Moses Tr. at 102:21-104:5; Villanueva Tr. at 41:10-42:12; Citi Ex. 66.)

Furthermore, as incentives, Opposer has long offered a number of loyalty rewards programs, through which consumers can receive travel rewards based on their use of Opposer's products and services, and are afforded the ability to use travel concierge and other facilitators. (Villanueva Tr. at 72:19-73:12.) All of these travel-focused programs are primarily, if not solely, CITI-branded, and all promotional materials and other customer-facing materials contain one or more CITI Marks. (E.g., Citi Exs. 81-89.) Moreover, because of the importance of travel to Citigroup's credit card customers, the ability to help consumers attain their travel objectives (whether through use of credit cards, rewards, discounts, or other benefits) is extremely important to its business, and, indeed, much of Opposer's advertising incorporates travel imagery in addition to the CITI Marks. (Villanueva Tr. at 25:9-26:4, 54:4-17, 69:24-71:4; see, e.g., Citi Exs. 66, 188.)

(i) **Credit Card Loyalty Programs**

Historically, Opposer has had several credit card loyalty rewards programs, allowing cardholders to accumulate "points" to be redeemed for travel, gift cards, merchandise, and/or statement credits. (Hines Tr. at 7:23-8:12.) These programs were (and remain) overwhelmingly CITI-branded, and the participating credit cards were CITI-branded. (Hines Tr. at 11:23-12:5.) Beginning in the 1990s, for instance, Opposer's CITIMILES loyalty program allowed customers with that credit card to earn "miles" for redemption on major airlines. (Moses Tr. at 82:12-16, 83:10-23; Villanueva Tr. at 14:16-15:15; Citi Ex. 188.) Notably, that credit card and program, in addition to being branded with the CITI Marks, also prominently featured an airplane logo (Citi Ex. 188):



As another example, for years Opposer offered a Citi Premierpass credit card and loyalty rewards program. (Hines Tr. at 31:6-32:19; Citi Exs. 82, 155.) Heavily promoted with that card was the customer's ability to earn points for the cost of their airline ticket, as well as points based on the distance of the actual flight – a perk known as "flight points." (Hines Tr. at 43:7-22.)

In 2005, Citigroup began consolidating its branded credit card rewards programs in the United States under the umbrella of a new ThankYou program, through which consumers would earn "ThankYou points" which could subsequently be redeemed for categories of items such as gift cards, travel, and merchandise. (Hines Tr. at 7:23-8:12.) Though the ThankYou program was initially intended to be a coalition program with external partners, since 2010 the program has included only "internal" partners, i.e. other CITI business units, and consumers earn points based on their relationships with those business units – including checking accounts, small business accounts, or Citi ThankYou credit card accounts. (Hines Tr. at 7:23-9:16.) Accordingly, as of at least that time, the program has been intensely CITI-branded, and primarily now is referred to as "Citi ThankYou Rewards." (Hines Tr. at 11:23-12:5; Citi Exs. 81, 83, 85, 86, 88, 89.) ThankYou members also receive discounts and companion ticket offers for travel booked using Citi ThankYou credit cards. (Hines Tr. at 38:12-39:3; Citi Ex. 85, at OPP0136551; NOR Ex. 606.)

Opposer currently has approximately ***** Citi ThankYou members, including approximately ***** Citi-branded credit card customers⁶ and ***** retail bank customers in the United States. (Hines Tr. at 13:2-14:11.) Since 2007, approximately *****% of ThankYou points redeemed have been for travel rewards, with ***** comprising air travel. (Hines Tr. at 14:12-15:11.) In 2011 alone, the ThankYou points redeemed for airfare were valued at approximately \$*****. (Hines Tr. at 15:3-20.) Over *****% of redemptions for airfare

⁶ This credit card account figure does not include approximately ***** holders of AT&T and Expedia cobranded cards. (Hines Tr. at 14:4-11.)

or hotels are completed through the ThankYou Travel Center. (Hines Tr. at 10:11-11:11; see Citi Ex. 84.)

It is worth noting that the ThankYou Travel Center, functioning since 2006, "looks very similar to any other online travel site," including that of Applicant, and allows customers to pay using their chosen combination of points and cash. (Hines Tr. at 10:11-11:12, 40:24-41:7; Citi Ex. 84.)⁷

Citigroup supports the Citi ThankYou program with significant advertising, including solicitations to prospective and current card holders, television advertising, digital advertising, and e-mail blasts. (Hines Tr. at 16:1-14; Citi Exs. 81, 83, 85, 161-163, 166.) To put these promotional activities in context, Citigroup annually sends acquisition mail for the Citi ThankYou credit cards to over ***** existing customers and ***** prospective customers. (Hines Tr. at 16:11-17:11, 19:2-22; see Citi Ex. 85.) Ultimately, Citigroup's above-the-line advertising spend (i.e. excluding direct mail) in the United States for its Citi ThankYou program in 2011 alone exceeded \$*****. (Hines Tr. at 21:2-13.)

All of the promotional materials disseminated by Opposer in support of the Citi ThankYou program since its inception, as well as the credit cards and member account material themselves, contain one or more CITI Marks. (Hines Tr. at 18:1-4; 20:1-12; Citi Exs. 81, 83, 85, 86, 88, 89.) In addition, because Citigroup considers the travel rewards aspect of its program to be a key component and a differentiator from other cards in the marketplace, much of the advertising for the Citi ThankYou program focuses on travel. (Hines Tr. at 23:2-12, 48:22-49:4; Villanueva Tr. at 25:9-26:2; Citi Exs. 81, 162, 163, 166.) For instance, not only are "flight points" available and advertised (see Citi Ex. 86, at OPP010817 & Citi Ex. 155), but Opposer also promotes the fact that certain of the available card products eliminate foreign transaction fees. (Citi Ex. 89, at OPP010569; Hines Tr. at 47:18-48:21.)

(ii) Co-branded Credit Cards

For more than 25 years, Citigroup has offered, and continues to offer, a number of co-branded credit cards in the United States (and worldwide), through which consumers could earn points to be used

⁷ These travel booking services are provided by a third party vendor and Opposer receives a portion of revenues from certain of the bookings. (Hines Tr. at 11:13-22, 66:13-67:1, 93:4-11.)

towards travel purchases with external partners, including the Citi AAdvantage program, the Citi Hilton HHonors program, and the Expedia co-brand card. (Baum Tr. at 4:13-20, 7:9-15.)

Citigroup's co-brand partnership with American Airlines and its AAdvantage program, for instance, has existed since 1987, and continues to be widely promoted nationwide. (Baum Tr. at 7:9-23, 48:1-6.) Citigroup offers approximately 8 cobranded credit card products with American Airlines to consumers in the United States, including a CitiBusiness cobranded card for small business customers.⁸ (Baum Tr. at 9:10-10:2; see, e.g., Citi Ex. 9.) Cardholders participate in the AAdvantage program, which allows American Airlines fliers to redeem earned "miles" for flights with American Airlines or its partners.⁹ Cardholders also receive additional perks such as free checked bags, priority boarding, Admirals Club membership, no foreign exchange fees, in-flight discounts, and accelerated earn for certain purchases. (Baum Tr. at 7:24-8:11, 50:19-51:1; Citi Ex. 5.)

***** (Baum Tr. at 22:7-23:7.)

This co-brand relationship is heavily promoted both by Citigroup and American Airlines. (Baum Tr. at 23:10-28:5; see, e.g., Citi Exs. 1-8.) Opposer on its own spends ***** promoting the Citi AAdvantage card program in the United States, including through direct mail pieces to active American AAdvantage members, Citi AAdvantage cardholders, and other prospects; websites; Citibank branches; internet advertising on card aggregator and travel sites; and paid internet search advertisements. (See id.) Indeed, each year Opposer sends out more than ***** on behalf of its Citi AAdvantage program to ***** AAdvantage members alone, as well as ***** other prospects. (Baum Tr. at 18:4-19:13, 69:11-70:15; Citi Ex. 4.)

Opposer also does extensive advertising in airports, including in flight terminals, American Airlines Admirals Clubs, car rental and parking shuttles, and in-flight magazines and videos. (Baum Tr.

⁸ These products also include cards cobranded with Mastercard and American Express. (Baum Tr. at 10:3-10, 33:15-19.)

⁹ Approximately ***% of miles redeemed under the program are for air travel. (Baum Tr. at 8:12-20.)

at 16:5-17:24, 26:5-28:12; Citi Exs. 2, 3.) This airport advertising, in use since at least 2007, includes blanketing virtually the entire American Airlines terminal at John F. Kennedy Airport in New York, as well as other hub airports, with advertising including the CITI Marks. (Baum Tr. at 26:5-28:2.)¹⁰ American Airlines itself advertises the Citi AAdvantage program via direct mail (sent out to approximately ***** customers per month), cross-selling via telephone and statement inserts. (Baum Tr. at 12:9-25, 20:4-22:6, 25:11-26:11; Citi Exs. 5, 8.)

All marketing supporting the Citi AAdvantage product, whether by Opposer or American Airlines, is heavily Citi-branded. (Baum Tr. at 13:1-4; Citi Exs. 1-10, 12, 13.) In addition, for the past 25 years, the co-branded cards themselves, as well as the marketing materials, have contained the shaded jet stream logo treatment, as well as other travel imagery such as airplanes. (Baum Tr. at 53:3-55:2; Citi Exs. 4 & 5.)

Since at least 2008, Citigroup has also offered a Citi Hilton HHonors credit card product, allowing cardholders nationwide to earn Hilton HHonors rewards points for qualified purchases, which can be redeemed for hotel stays on Hilton properties, upgrades, and other travel benefits (including no foreign exchange fees). (Baum Tr. at 41:1-19, 50:19-51:1.) That relationship is marketed on Opposer's and Hilton's websites, as well as through other means, and all associated materials bear the Citi Marks. (Baum Tr. at 44:1-45:15; Citi Exs. 14, 15.) Currently, there are more than ***** domestic cardholders of a Citi Hilton HHonors credit card in the United States. (Baum Tr. at 49:3-10.)

Finally, Opposer offers a Citi Expedia co-brand credit card, whereby cardholders can earn discounts on flights, as well as Citi ThankYou points. Citigroup currently has well over ***** Citi Expedia cardholders nationwide. (Baum Tr. at 45:16-47:6; Hines Tr. at 10:1-10.)

¹⁰ *****

(Baum Tr. at 29:8-16; Villanueva Tr. at 45:17-46:23.)

(iii) CitiTravel

Since the 1980s Citigroup has offered United States cardholders the opportunity to be members of the CitiTravel program, which provides discounts on various travel arrangements, including hotels, airfare, and dining. That program allows its members to book such arrangements, including air travel, directly through Opposer.¹¹ (Moses Tr. at 84:7-91:5.) Opposer has disseminated promotional materials in support of the program throughout its decades of existence, all of which bear one or more CITI Marks. (Citi Exs. 20, 22, 23, 24, 26, 28-30.) Significantly, the program has over the years used several "CITI" vanity telephone numbers, through which members could book their desired travel. (Citi Exs. 20, 22, 23.) Opposer has also used travel imagery such as airplanes in promoting the program. (Citi Ex. 24.)

5. Opposer's NRI-Targeted Business

Citigroup markets and provides the services described above to consumers and corporate clients nationwide, as well as throughout the world. (See generally NOR Exs. 554-564.) In addition, for 20 years Citigroup has been providing certain additional services targeted to the Non-Resident Indian population, defined by Indian law to include anyone with Indian heritage living abroad. (Nariman Tr. at 6:17-7:8, 10:19-25.) The NRI program is a global program, and includes the United States, Singapore, Middle East, and Europe, among other areas. (Nariman Tr. at 10:23-25, 37:2-38:7; Citi Ex. 136.)¹²

In the United States, Opposer offers specialized banking products for NRIs, i.e. bank accounts in India which are not typical FDIC-insured products. (Nariman Tr. at 7:9-9:4; Citi Ex. 138.) These accounts in India allow Opposer's United States customers to transfer money seamlessly between their United States and Indian accounts, as well as earn the favorable interest rates available in India. (Nariman Tr. at 7:23-10:11.) Moreover, Opposer offers a number of other benefits to holders of NRI accounts. (Nariman Tr. at 26:20-28:14; Citi Exs. 138, 141.) As the majority of NRI customers travel

¹¹ The actual booking services are provided by a third party vendor with which Opposer contracts. (Moses Tr. at 85:10-18.)

¹² Separate and apart from its NRI business, Opposer also offers a full range of services in many of these areas, including in India and Singapore. (Nariman Tr. at 32:14-33:2, 36:21-37:1; Moses Tr. at 101:17-102:3; Citi Exs. 113-119; NOR Exs. 548-552.)

frequently (particularly to India and Singapore), many of the promoted benefits are travel-related.

(Nariman Tr. at 27:10-28:10.)

In each of the past six years, Citigroup has had in excess of ***** NRI customers in the United States. (Nariman Tr. at 13:13-25; Citi Ex. 120.) The states with the most NRI customers are

***** (Nariman Tr. at 13:2-12; Citi Ex. 120.)

***** (See Nariman Tr. at 14:1-9, Citi Ex. 120.) To that end, Opposer concentrates its marketing efforts on geographic areas in the United States with a large proportion of NRIs. (Nariman Tr. at 13:2-12.) Opposer promotes its NRI business through a dedicated website, which contains several CITI Marks as well as multiple links to other of Opposer's services (Citi Exs. 136, 138, 141), and through CITI-branded print advertisements, informational fliers in branches, radio and television commercials on media outlets targeted at NRI populations, and internet advertisements on Indian cultural websites (such as www.eknazar.com). (Nariman Tr. at 11:1-12:2; see Exs. 109-112, 121, 150-153.)

NRI relationship managers occasionally attend and distribute promotional materials at Indian cultural events and other events attended by significant NRI populations. (Nariman Tr. at 31:1-32:1.) Opposer has for years sent targeted mailings to existing NRI customers (i.e., 125,000 mailings in 2007 alone). (Villanueva Tr. at 63:8-24; Citi Ex. 103.) All of Opposer's promotional activity relating to the NRI business is CITI-branded. (Nariman Tr. at 46:25-48:1; see, e.g., Citi Exs. 109-111, 150-153.)

6. Fame and Strength of the CITI Marks

Over at least the past two decades, the CITI Marks have been widely recognized by the general consuming public of the United States as a designation of the source of the services offered by Opposer. Indeed, courts, as well as the TTAB, have held the CITI and CITIBANK marks to be famous, including under the more stringent dilution standard of fame. E.g., CIT Grp., Inc. v. Citicorp, 20 F. Supp. 2d 775, 793 (D.N.J. 1998) ("Citigroup is one more addition to the family of CITI names which, through extensive use and advertising have become internationally famous."); Citigroup Inc. v. City Holding Co., 171 F. Supp. 2d 333, 346, 351-52 (S.D.N.Y. 2001) (At least as of 1990, "there is no question that CITI family of

marks is famous within the meaning of the [Federal Trademark Dilution Act]"); Citibank, N.A. v. City Bank of S.F., 206 U.S.P.Q. 997 (N.D. Cal. 1980); Citigroup Inc. v. Capital City Bank Grp., Inc., 94 U.S.P.Q.2d 1645, 1658 (T.T.A.B. 2010) (CITIBANK family of marks famous for likelihood of confusion and dilution purposes as of 1983), aff'd, 637 F.3d 1344, 98 U.S.P.Q.2d 1253 (Fed. Cir. 2011). (See Moses Tr. at 46:11-48:11.)

The strength of the CITI Marks derives not just from the inherent distinctiveness of the master brand CITI, but also because of the acquired distinctiveness of the marks from the enormous market strength the family has gained in recent decades, as discussed below:

(a) Scope of Citi-branded Business

Opposer derives enormous revenue and income from services it provides under its CITI Marks. (Citi Ex. 42; NOR Exs. 554-564.) As of December 31, 2011, for instance, Opposer's North America Regional Consumer Banking division¹³ included 1,016 retail bank branches and 12.7 million customer accounts, largely concentrated in New York, California, Chicago, Miami, Washington, D.C., Boston, Philadelphia, and Texas. (NOR Ex. 564, at OPP008482, see also Villanueva Tr. 33:11-34:2.)¹⁴ As of that date, that division had \$38.9 billion of retail banking loans and \$148.8 billion of deposits. (NOR Ex. 564, at OPP008482.) With respect to the North American Citi-branded credit card business, the division had 22 million credit card accounts, with \$75.9 billion in outstanding card loan balances and over \$8.5 billion in revenues. (NOR Ex. 564, at OPP008482.)¹⁵

Financial results from earlier years indicate similarly significant revenues from Opposer's CITI-branded retail banking and credit card services, with over \$10 billion in North American credit card

¹³ The United States represents over ***% of Opposer's North American business. (Villanueva Tr. at 28:4-17.)

¹⁴ Ms. Villanueva confirmed that Citigroup's annual reports are business records, which she believes to be accurate. (Villanueva Tr. at 26:9-27:9.)

¹⁵ Again, approximately ***% of this is attributable to the United States. (Villanueva Tr. at 28:4-17.)

revenues and \$16.5 billion in North American consumer banking revenues in the 2008 fiscal year. (NOR 561, at OPP007629; see also NOR Exs. 562 & 563; Villanueva Tr. at 29:18-33:10.)

(b) Opposer's Widespread Use of Websites

Opposer has long owned a number of key websites, all of which are branded with CITI Marks. These include citi.com, citigroup.com, citibank.com, citidirect.com, and citicards.com. (Moses Tr. at 54:3-11; Villanueva Tr. at 39:13-15; Citi Exs. 41-42, 45, 63; NOR Exs. 541-543, 553, 576.) Citibank Online, for instance, accessible through www.citi.com and www.citibank.com, allows customers or potential customers to link to Opposer's retail bank online, regardless of location. (Villanueva Tr. at 66:15-67:5.) Citibank Online is predominantly CITI-branded, and there are numerous links from the homepage to Citigroup products which are also branded with one or more CITI Marks, such as Citicards. (Citi Ex. 63; NOR Exs. 541-543, 553)

Opposer also owns www.citigroup.com, Citigroup's primary corporate website which educates consumers regarding the products and services offered by Opposer. (Villanueva Tr. at 23:21-24:16; Citi Exs. 41-42.) Almost all of the products and services identified on citigroup.com are branded with a CITI Mark, and the homepage also links to a number of Citigroup business units which provide services branded with CITI Marks. (Citi Exs. 41, 42.) Furthermore, CitiDirect, accessible at www.citidirect.com,

is Opposer's institutional client website which provides a portal for clients to manage their accounts and perform transactions. (Villanueva Tr. at 16:10-16; Moses Tr. at 56:5-11; Citi Ex. 45.)

Ultimately, the important services offered by Opposer to its customers online are used by millions of customers nationwide (as well as throughout the world). For this reason, Citigroup has been expanding its websites' functionality to allow customers to conduct their banking activities over their mobile devices. (Villanueva Tr. at 67:8-17.)

(c) Advertising and Promotion

Over the last four to five years, Citigroup has spent at least \$***** in the United States on advertising in support of its CITI brand. (Villanueva Tr. at 44:18-45:16.) Such advertising, much of it national in scope, allows Opposer to reach consumers in geographic areas where it does not maintain branches, thus facilitating the expansion of nationwide enterprises such as its pervasive credit card business. (Villanueva Tr. at 55:16-56:8.) All of Opposer's advertising includes references to at least one CITI Mark, and often several CITI Marks are used as a family, i.e. referenced together and identified as coming from the same source – Citigroup. (Villanueva Tr. at 8:16-25; see, e.g., Citi Ex. 39.)

Opposer's advertising also includes sponsorships such as Citi Field, Citi Open, Citi Pond, and the 2012 United States Olympic and Paralympic teams. In these sponsorships, the CITI Marks appear in the identification of the sponsor, as well as in connection with special discounts and other privileges available to Opposer's customers (and occasionally non-customers) at those venues. (Villanueva Tr. at 16:17-18:16; Moses Tr. at 45:4-25.)

As a significant portion of its advertising budget, Opposer spends millions of dollars annually on television advertising, both in support of the CITI brand in general and in support of specific products such as credit cards (e.g., Citi Exs. 156, 158, 160, 163, 166) or the NRI business (Citi Exs. 150-153). (See generally Citi Exs. 150-153, 155-166.) For instance, Citigroup has run extremely prominent television commercials for its recent 200th anniversary, as well as its sponsorship of the 2012 United States Olympic and Paralympic teams. (Citi Exs. 164, 166.)

Opposer also extensively promotes its consumer credit card business, including the loyalty rewards programs offered thereunder. As an example, Citigroup historically has run, and continues to run, many television commercials for its CITI ThankYou and CITI AAdvantage programs. (E.g., Citi Exs. 156, 157, 161-163.) One 2010 travel-related credit card commercial in particular generated enormous publicity. (Villanueva Tr. at 53:1-54:3; Citi Ex. 163.) Also in support of the consumer credit card business, Citigroup sends out millions of mailings on an annual basis nationwide – for instance, approximately ***** mailings on behalf of the credit card business alone in 2007. (Villanueva Tr. at 34:19-37:4; e.g., Citi Ex. 46.) These mailings are sent both to customers and to prospective customers, and all contain references to at least one CITI Mark. (Villanueva Tr. at 34:19-37:4.)

(d) Media Coverage/References

Media references to Opposer, favorable or otherwise, are widespread. Such references include both solicited and unsolicited publicity in the forms of newspaper articles, press releases, magazine articles, and television spots. (Moses Tr. at 48:12-49:25, 50:19-22; Villanueva Tr. at 58:1-59:1; NOR Exs. 501-540.) Events generating enormous levels of publicity in recent decades included the 1998 merger between Citicorp and Travelers Group, the "CITI NEVER SLEEPS" campaign beginning in the late 1970s and the "IT'S YOUR CITI" campaign beginning in 1984, the introduction of ATMs, and the financial crisis of recent years. (Moses Tr. at 50:1-18.) Citibank has even been the subject on several occasions of parodies on NBC's Saturday Night Live. (Moses Tr. at 51:20-53:2.) In general, virtually all such publicity has referred to Opposer as "Citi" or "Citibank." (Villanueva Tr. at 59:2-23.)

(e) **Brand Awareness Research**

Quantitative brand tracking studies – both Citigroup's and those completed independently – since at least as early as 1990 have indicated that over **% of consumers in the United States are aware of the CITIBANK/CITI brands.¹⁶ (Michelini Tr. at 10:2-7; Citi Exs. 98, 99, 101, 102.)

(i) **Citigroup Sponsored Research**

Opposer has been conducting corporate imagery studies analyzing consumer awareness of the CITI and CITIBANK marks for over 20 years. (Michelini Tr. at 7:19-22; see Citi Exs. 98, 99, 101, 102.) All of Opposer's studies, dating back to at least 1990, have been conducted according to widely accepted and standard methodologies. (Michelini Tr. at 11:8-17, 14:3-11, 27:2-7, 30:13-21.) The resulting reports have confirmed that Opposer's CITI brand is widely recognized by United States consumers. Overall (total) awareness levels of the CITI Marks have been extremely high for decades, consistently at over ***** since 1990 and continuing through the current time. (See Citi Exs. 98, 99, 101, 102.) In 1990, for instance, aided awareness was *****.
(See Michelini Tr. at 12:10-15; Citi Ex. 101 at OPP000050.) In 1995, that figure was **%. (Michelini Tr. at 14:23-15:2; Citi Ex. 102, at OPP000451.)

More recent surveys (i.e., post-2000), also using well-accepted methodologies, similarly confirm brand familiarity levels of over **% of Opposer within its market areas. (Michelini Tr. at 27:21-28:14; Citi Ex. 99 at OPP010826.) Significantly, aided awareness of the CITI brand in the credit card field is approximately **%. (Michelini Tr. at 31:19-32:1; Citi Ex. 99, at OPP010828.) These reports show that Opposer's aided awareness levels have continued to be among the highest of any banking or financial institution, including such well-known brands as *****.

¹⁶ Studies prior to the past decade focused on consumers' awareness of "Citibank," as that was the primary way the bank was referenced prior to 2000. (See Citi Exs. 101, 102.) However, for at least the past three to four years, awareness studies have focused on the mark CITI, as CITI solidified its position as Opposer's "master brand." (Michelini Tr. at 16:1-11, 32:15-33:1.)

(ii) **Non-Sponsored Research**

Brand awareness studies conducted completely independently of Opposer also confirm the fame of the CITI brand. (Citi Exs. 98-99; see generally Michelini Tr. at 24:13-25:3, 28:18-29:13.)

***** (Citi Ex. 98, at OPP000766; Ex. 99, at OPP010827.) These BrandZ analyses are widely respected and relied upon in the consumer research field as accurate indicators of brand strength. (Michelini Tr. at 20:1-22:11.)

* * *

This uncontroverted evidence overwhelmingly establishes that the CITI brand is extremely strong in the United States, and certainly qualifies for (i) the highest degree of trademark protection, and (ii) famous mark status for the purposes of the application of likelihood-of-dilution principles.

ARGUMENT

I.

REGISTRATION OF THE PENDING APPLICATION WOULD AUTHORIZE USAGES THAT WOULD BE LIKELY TO BE CONFUSED WITH OPPOSER'S CITI MARKS

The facts set forth above readily explain why Opposer has both the right and the obligation to ensure that the federal register remains free of "CITI" marks in the business areas in which Opposer operates, and those business areas in close proximity thereto. If the pending Application proceeds to registration, Citiair would have rights on a nationwide basis to use a CITI-prefixed mark for travel services – services which, though not Citigroup's primary services, have been an extremely important part of Opposer's business for decades. This, when measured against the enormous strength and presence of Opposer's CITI brand, the fact that the parties target the same demographic, and the striking similarity of the marks at issue, would without question result in a likelihood of confusion.

A. Ownership and Priority

There can be no dispute that Opposer owns a family of CITI Marks, and that such marks have been in use well prior to Applicant's claimed first use of its CITIAIR mark (2009). The CITI mark has been federally registered since 1981, and CITIBANK has been registered since 1960. At any given point during at least the past 20 years, there have been dozens of federally registered marks in the CITI family, and numerous others protected by common law rights. (Moses Tr. at 56:12-20, 23:24-26:16.) Opposer began to transition to a CITI "master brand" within several years after its business combination with Travelers Group in 1998, and today almost all of Opposer's businesses, products, and services are primarily branded with CITI and/or one or more CITI Marks. (Villanueva Tr. at 7:9-22, 19:22-20:11; Moses Tr. at 20:10-24.)

B. Applicable Legal Standards

In determining likelihood of confusion, the Board considers the familiar thirteen factors set forth in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).¹⁷

Generally, the two most important factors are the similarity of the marks and the similarity of the goods and services. See Federated Foods, Inc. v. Ft. Howard Paper Co., 544 F.2d 1098, 1103 (C.C.P.A. 1976). In addition, "[t]he fifth duPont factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection." Kenner Parker Toys Inc. v. Rose Art Indus., 963 F.2d 350, 352, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992) (emphasis added); see also Nina Ricci, S.A.R.L. v. E.T.F. Enters., 889 F.2d 1070, 1073, 12 U.S.P.Q.2d 1901, 1903 (Fed. Cir. 1989) (Board did not accord enough weight to fame and strength of NINA RICCI mark). All doubt should be resolved against Applicant, because "there is 'no excuse for even approaching the well-known trademark of a competitor.'" Nina Ricci, 889 F.2d at 1074, 12 U.S.P.Q.2d at 1904 (citation omitted). And, where, as here, the marks are extremely similar, the required degree of similarity of the services provided is reduced. See In re Thor Tech. Inc., 90 U.S.P.Q.2d 1634, 1636 (T.T.A.B. 2009).

Here, Factors 1, 2, and 5 (i.e. similarity of the marks, similarity of services, and fame of the prior mark) strongly favor Opposer, and can be considered dispositive. In any event, no DuPont factor weighs in favor of Applicant.

¹⁷ These are: (i) similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impressions; (ii) similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (iii) similarity or dissimilarity of established, likely-to-continue trade channels; (iv) the conditions under which and buyers to whom sales are made; (v) fame of the prior mark; (vi) the number and nature of similar marks in use on similar goods; (vii) the nature and extent of any actual confusion; (viii) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (ix) the variety of goods on which a mark is or is not used (house mark, "family" mark, product mark); (x) the market interface between applicant and the owner of a prior mark; (xi) the extent to which applicant has a right to exclude others from use of its mark on its goods; (xii) the extent of potential confusion, i.e., whether de minimis or substantial; and (xiii) any other established fact probative of the effect of use. See Dupont, 476 F.2d at 1361, 177 U.S.P.Q. at 567.

C. Factor 1: Similarity of the Marks

The first DuPont factor, the similarity of the marks, is, as noted, a "predominant inquiry." Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 1265, 62 U.S.P.Q.2d 1001, 1003 (Fed. Cir. 2002). That factor examines the marks' appearance, sound, connotation, and commercial impression. See id. For there to be a likelihood of confusion, absolute identity is not required. See 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:20 & n.2 (4th ed. 2008) (hereinafter "McCarthy"); Kenner Parker Toys, 963 F.2d at 354-55, 22 U.S.P.Q.2d at 1457-58 (FUNDROUGH mark for toy modeling compounds likely to be confused with PLAY-DOH mark for similar products). Rather, all that is necessary for likelihood of confusion is enough similarity between the marks to contribute to consumer confusion. See 4 McCarthy § 23:20. When the dominant feature of conflicting marks is the same, the likelihood of confusion increases, particularly where such dominant feature is distinctive. See, e.g., Hewlett-Packard, 281 F.3d at 1266, 62 U.S.P.Q.2d at 1004. Furthermore, where a trademark owner owns a family of marks, i.e. a group of marks used together in association with each other, it is sufficient for the mark owner to show that the challenged mark is likely to be viewed as a member of the owner's family of marks. Black & Decker Corp. v. Emerson Elec. Co., 84 U.S.P.Q.2d 1482, 1491 (T.T.A.B. 2007).

Here, there can be no dispute that CITI is the dominant element of Applicant's mark, and thus it is the element that will stand out for consumers. Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772, 396 F.3d 1369, 1372-73, 73 U.S.P.Q.2d 1689, 1692-93 (Fed. Cir. 2005). The presence of the term "Air" in Applicant's mark is not a material point of difference, given that, as acknowledged by Applicant, that word is essentially descriptive of the services provided under that mark. (Raj Tr. at 13:6-14:11.) See In re Nat'l Data Corp., 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985). Indeed, many members of Opposer's famous family of CITI-prefixed marks are one-word marks consisting of the term CITI followed by a descriptive term. Examples include CITITRAVEL and CITIBUSINESS. (NOR Ex. 567, Amended Notice of Opposition, Ex. A (Docket No. 5).) Thus, that Opposer does not own a federal registration for, or use, the mark CITIAIR itself, is of no consequence, as Applicant's mark is

likely to be understood by consumers to be a member of the family of CITI Marks. See, e.g., Black & Decker, 84 U.S.P.Q.2d 1482, 1491 (T.T.A.B. 2007) ("[T]he question is not whether each of applicant's marks is similar to opposer's individual marks, but whether applicant's marks would be likely to be viewed as members of opposer's HOG family of marks.").

Nor does the fact that the applied-for mark is a design mark change the outcome of the analysis. First, where a mark contains a design element, the word portion generally is accorded greater weight. In re RSI Sys., LLC, 88 U.S.P.Q.2d 1445, 1448 (T.T.A.B. 2008). Moreover, as Applicant testified, the logo, a silhouette of an airplane on a blue background, is merely descriptive of the services provided under the mark. (Raj Tr. at 21:3-22:6.) Indeed, Opposer has often used airplanes and other travel elements in its marketing, for instance for its CITIMILES rewards program:



In addition, Opposer has long used the color blue in its branding (e.g., the current blue wave design element). (Moses Tr. at 19:9-20:5.) And, the CITIAIR mark is currently also used as a word mark, and not just as a design mark. (Raj Tr. at 63:8-12.)

In sum, this factor weighs strongly in favor of Opposer.

D. Factor 2: Similarity of Services

Applicant has cited "travel booking agencies" services in its Application, and Mr. Raj has testified that "99.9" percent of Applicant's business consists of selling airfare between the United States and India. (Raj Dep. at 24:7-15.)

Although the bulk of Opposer's business is in financial services, there can be no dispute that Opposer also has historically offered consumers numerous travel-related services as well, including the following: Citicorp Travelers' Checks, a significant business in the 1980s and 1990s; travel-specific corporate and government credit cards; the CitiTravel program (since the 1980s); co-brand credit card relationships (e.g. Citi AAdvantage, Citi Hilton HHonors, and Expedia co-brand cards); and the Citi

ThankYou program (and, before that, other credit card rewards programs such as CitiMiles and Citi Premierpass). (See Statement of Facts, supra, Section D(4)(d).) Through these businesses, Opposer annually provides its customers with millions of dollars' worth of travel-related services, including the ability to directly book travel through Opposer's websites or toll-free telephone numbers (many of which include the term CITI).¹⁸ As noted, in a recent year, Opposer's customers redeemed Citi ThankYou points for approximately \$***** in air travel. (Hines Tr. at 15:3-20.) Indeed, ***** (Raj Tr. at 43:8-16), is a partner of Opposer in its travel benefits program. (E.g., Citi Ex. 133.)

Accordingly, the services provided by Opposer are extremely close to, if not indistinguishable from, those provided by Applicant. Thus, if a United States consumer seeks to book a flight to India, he or she could purchase the airfare from Applicant (perhaps using a CITI-branded credit card), or could obtain that same flight ticket from Opposer for free or using some combination of points and money.

Moreover, Opposer also extensively promotes its financial products in travel-related contexts. For instance, Citigroup engages in extensive airport and airplane advertising. (Baum Tr. at 26:5-28:12.) Opposer also aims to promote its credit card products in an aspirational context, i.e. helping consumers achieve their desires, and travel is a significant component of that. (Villanueva Tr. at 25:9-26:4, 54:4-17, 69:24-71:4.) Thus, airplanes and other travel imagery are constant fixtures in Opposer's websites and promotional materials. (Id.)

Though Applicant apparently takes issue with the absence of the term "travel" in most of Opposer's many CITI-prefixed trademark registrations (see Moses Tr. at 112:7-113:14), it bears noting that Opposer does in fact own the federally registered marks CITITRAVEL (since 2005) and CITIMILES (since 1995). (NOR Ex. 567, Amended Notice of Opposition, Exs. A & B (Docket No. 5).) In addition, Opposer owns several trademark registrations that cite credit card rewards programs in their iteration of

¹⁸ As noted, the actual booking services provided through these websites and telephone numbers are provided by third party vendors with which Opposer contracts. (Hines Tr. at 11:13-22, 66:13-67:1, 93:4-11.)

goods and services, which, by the generally accepted understanding of the term, necessarily include travel-related rewards. These include: CITIBANK (and Design) (registered 2009); CITI BONUS CASH CENTER (registered 2008); CITIDOLLARS (registered 2008); CITI EXECUTIVE (registered 2011); CITI FORWARD (registered 2009); and CITI THANKYOU (registered 2011). (Id. Ex. A.) Thus, the service descriptions overlap, and this factor strongly favors Opposer.

E. Factor 5: Fame and Strength of the CITI Marks

As noted, "[f]amous or strong marks enjoy a wide latitude of legal protection." Kenner Parker Toys, 963 F.2d at 352, 22 U.S.P.Q.2d at 1456. There is no question that the CITI Marks are famous and highly distinctive, and have been for many years. See Citigroup Inc. v. City Holding Co., 171 F. Supp. 2d 333, 346 (S.D.N.Y. 2001).

As described above in the Statement of Facts (Section D(6)(e) supra), branding studies dating back to at least as early as 1990 document very high mark awareness levels. Additional persuasive evidence, also cited above, confirms the continuing great strength of the CITI Marks:

- The enormous scope and breadth of the CITI-branded retail bank, credit card (commercial and consumer) business, and commercial banking business, as well as loyalty rewards programs touching many millions of consumers;
- The popularity of Opposer's CITI-branded websites, including www.citibank.com, www.citi.com, www.citigroup.com, www.citicards.com, and www.citidirect.com;
- Tens of millions of dollars spent annually on extensive national advertising and promotion of the CITI brand, including sponsorships, mailings, and television commercials; and
- Enormous media coverage, both solicited and unsolicited.

(Statement of Facts, Section D(6), supra.)

Finally, the CITI Marks have inherent strength because CITI is not descriptive or generic. See Citigroup Inc., 171 F. Supp. 2d at 346. In sum, the fifth DuPont factor, the fame and strength of the CITIBANK marks, strongly favors Opposer.

F. Factor 3: Channels of Trade

Where, as here, an application does not limit the channels of trade for the cited services, the Board assumes that the standard channels of trade apply. See In re Broadview Advisors, LLC, U.S. Ser.

No. 78/366,359, 2007 WL 1022703, at *4 (T.T.A.B. Mar. 27, 2007). Obviously, travel services are often offered through "bricks and mortar" locations. Applicant has, in fact, stated its intentions to open such locations throughout the United States, *****

***** (NOR Ex. 564, at
OPP008482; Citi Ex. 120.)

Even the fact that Applicant's current business is conducted primarily over the internet (using "CITI" domain names) and over the phone (using a "CITI" telephone number) is not a point of distinction, as Opposer has for years owned a number of CITI-prefixed websites and vanity telephone numbers through which it provides its services, including travel booking services. (Moses Tr. at 25:2-26:16, 86:25-87:8; Citi Exs. 20, 22, 23.) Indeed, Applicant's website is virtually indistinguishable in format from Citigroup's ThankYou Travel Center website. (Compare App Ex. 2 with Citi Ex. 84.)

There are other overlaps as well. Applicant focuses on the exact demographic targeted by Opposer's robust NRI services. (Compare Raj Tr. at 17:14-19:4 with Nariman Tr. at 6:17-7:8, 10:19-25 & Citi Ex. 120.) Applicant advertises in the same channels as Citigroup's NRI business, i.e. traditional Indian websites, festivals, and print media. (Compare Raj Tr. at 22:25-23:20, 26:5-27:12, 35:7-36:5, 37:6-22 with Nariman Tr. at 11:1-12:3 & Citi Exs. 109-112, 121, 150-153.) By way of example, Citigroup had a banner advertisement on an eknazar.com website page that also contained a Citiair advertisement. (Citi Ex. 112.)

Thus, the third DuPont factor strongly supports a finding of likelihood of confusion.

G. Factors 7 and 8: Actual Confusion and "Concurrent Use"

It is well settled that evidence of actual confusion is not required to prove that a likelihood of confusion exists. See, e.g., Nina Ricci, S.A.R.L., 889 F.2d at 1073, 12 U.S.P.Q.2d at 1903 ("[A]bsence of any showing of actual confusion is of very little, if any, probative value . . ."). Here, the absence of evidence of actual confusion is not surprising, for a number of reasons. First, Applicant has only been using the mark in the United States since 2009 (with modest revenues), and has been offering booking

services on its website for less than a year. In addition, because there are no bricks and mortar locations, there is no geographic overlap/"concurrent use" in that respect.

In the circumstances here, it is unlikely that evidence of actual confusion would come to the attention of Opposer. Courts have recognized that because "instances of actual confusion may be difficult to discover, [therefore] the most that the absence of evidence of actual confusion can be said to indicate is that the record does not contain any evidence of actual confusion known to the parties." CAE, Inc. v. Clean Air Eng'g, Inc., 267 F.3d 660, 686, 60 U.S.P.Q.2d 1449, 1467 (7th Cir. 2001) (25 years of coexistence); see also In re Azteca Rest. Enters., 50 U.S.P.Q.2d 1209, 1212 (T.T.A.B. 1999) (approximately 20 years of concurrent use).

Accordingly, the "confusion" factors do not weigh in favor of Applicant, but rather are neutral in the overall analysis.

H. Factor 6: Third-Party Uses Of CITI For Similar Goods and Services

Opposer's substantial policing efforts over the past two to three decades (i.e., after it began to expand nationally), especially policing the national registry, are well-documented. (See Moses Tr. at 70:10-81:12; Statement of Facts, Section B(1)(c) supra.) Significantly, Applicant here has failed to offer any evidence of third parties using the term "CITI" for the types of services at issue here. Thus, this factor strongly favors Opposer.

I. Factor 4: Degree of Care Exercised by Purchasers

As the Federal Circuit observed in Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank, 842 F.2d 1270, 6 U.S.P.Q.2d 1305 (Fed. Cir. 1988), bank customers are not invariably sophisticated. Rather, some may exercise care, but others do not. Id. at 1274, 6 U.S.P.Q.2d at 1308. In In re 1st USA Realty Prof'ls, moreover, the Board noted that that the consumers targeted by the applicant's and registrant's identified services were "the public at large," and, although "banking services and credit card services involve financial transactions . . . such services are [not] necessarily obtained only after careful consideration." 84 U.S.P.Q.2d 1581, 1587 (T.T.A.B. 2007). Accordingly, for purposes of a likelihood of confusion analysis, the Board found that bank customers as a rule exercise only

"ordinary care." Id. at 1587-88 (affirming refusal of registration); accord Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce, 228 U.S.P.Q. 689, 690 (T.T.A.B. 1986) (finding likelihood of confusion because the relevant universe of customers was "the great majority of the general public who are recipients in one form or another of banking services"), aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1 U.S.P.Q.2d 1813 (Fed. Cir. 1987).

Here, the majority of Opposer's customers in the travel field are credit card customers, who do not necessarily carefully consider these transactions. Similarly, virtually all of Applicant's transactions are conducted via credit card. Notably, Applicant's business model is to provide inexpensive tickets between the United States and India, thereby increasing the likelihood of confusion. Recot, Inc. v. Becton, 214 F.3d 1322, 1329, 54 U.S.P.Q.2d 1894, 1899 (Fed. Cir. 2000).

It is well established, moreover, that even relatively sophisticated purchasers are not immune from confusion as to origin or affiliation. See, e.g., In re Broadview Advisors, LLC, 2007 WL 1022703, at *4 ("[E]ven if [the Board] were to assume that both registrant's and applicant's customers are somewhat sophisticated in the field of finance, this does not necessarily mean that they are immune from source confusion when very similar marks are used on related services."); Charles Schwab & Co. v. Hibernia Bank, 665 F. Supp. 800, 811, 3 U.S.P.Q.2d 1561, 1569 (N.D. Cal. 1987) (consumer sophistication may even increase the likelihood of confusion between the parties' financial services inasmuch as they are more aware of the diversification of the financial services industry). For instance, sophisticated consumers may believe that a confusingly similar mark used on a new product or service comes from the same source as the senior user. E.g., In re Majestic Distilling Co., 315 F.3d 1311, 1316, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003) (holding that a consumer of RED BULL malt liquor could be led to purchase RED BULL tequila in the mistaken believe that the two are manufactured by the same entity); Palm Bay Imps., 396 F.3d at 1376, 73 U.S.P.Q.2d at 1690 (sophisticated consumers could believe that VEUVE ROYALE was Veuve Clicquot's sparkling wine).

Finally, courts have held that where, as here, "there is a high degree of similarity between the parties' services and marks, 'the sophistication of the buyers cannot be relied on to prevent confusion.'"

Morningside Grp. Ltd. v. Morningside Capital Grp., L.L.C., 182 F.3d 133, 143, 51 U.S.P.Q.2d 1183, 1190 (2d Cir. 1999) (citation omitted). Thus, this factor also weighs in favor of Opposer.

J. Factor 9: Variety of Goods on Which a Mark is Used

The ninth DuPont factor, evaluating "the variety of goods on which a . . . mark is or is not used," examines the nature of an opposer's (or other senior user's) use of its mark. In re Pearce & Pearce, U.S. Ser. No. 78/769,245, 2007 WL 4135840, at *5 (T.T.A.B. Nov. 7, 2007) (noting that the ninth factor focuses solely on the manner of use of the cited registrant's mark and not on third party use of the mark).

In its evaluation of this factor, the Board has considered a number of indicia, including the type of mark used by opposer (*i.e.* a family of marks as compared to a single mark), the variety of products containing the mark, and the mark's zone of expansion. See Black & Decker, 84 U.S.P.Q.2d at 1495 (ninth DuPont factor weighed in opposer's favor where opposer had a family of HOG marks, since consumers encountering applicant's WATER HAWG or DIRT HAWG marks for similar services would thus likely think that opposer had expanded its family); Nike, Inc. v. WNBA Enters., LLC, 85 U.S.P.Q.2d 1187, 1195 (T.T.A.B. 2007) (opposer's use of its mark in connection with a variety of sports products increases the likelihood that purchasers, when seeing a similar mark used in connection with backpacks and other sports bags, would be confused as to the origin of such goods); Cordis Corp. v. Furnary, Opp. No. 99,988, 2002 WL 31018163, at *5 (T.T.A.B. Sept. 9, 2002) (where a mark was used as a house mark and as the trade name in connection with a wide variety of goods, the factor weighed in favor of confusion). The Board has also held that a senior user's mark used on a wide variety of goods and services merits a wider scope of protection. In re Am. Med. & Life Ins. Co., U.S. Ser. No. 75/493,928, 2002 WL 31302626, at *2 (T.T.A.B. Oct. 11, 2002).

There can be no doubt here that Opposer owns a famous family of CITI Marks, both registered and unregistered. (See Statement of Facts, Sections D(2) & D(6), supra.) Opposer has also shown that the CITI Marks identify a broad and comprehensive array of products and services, including consumer and corporate banking and credit card services, in a wide variety of International Classes. (See NOR Ex. 567, Amended Notice of Opposition Ex. A (Docket No. 5).) Two of Opposer's registrations for CITI

Marks, moreover, are in International Class 39, the same International Class in which Applicant claims to provide its services. (Compare id. (CITIMILES, CITITRAVEL) with NOR Ex. 566.) Accordingly, this factor strongly favors Opposer.

K. Factor 10: Market Interface Between Applicant and the Owner of the Prior Mark

In analyzing the "market interface between applicant and [an opposer]," DuPont specifically enumerated the following considerations to be considered by the Board:

- (a) a mere "consent" to register or use,
- (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party,
- (c) assignment of the mark, application, registration and goodwill of the related business and
- (d) laches and estoppel attributable to owner of prior mark and indicative of a lack of confusion.

476 F.2d at 1361, 177 U.S.P.Q. at 567.

There has been no period of knowing coexistence here, as Citigroup first learned of Applicant's existence when the Application was filed, and promptly filed this Opposition. (See Statement of Facts, Section A, supra.) Accordingly, this factor provides no support to Applicant's position, and, if not neutral, actually favors Opposer.

L. Factor 11: The Right To Exclude Others

The relevant consideration in evaluating this DuPont factor is the extent to which an applicant has the right to exclude other parties from using its marks. See Am. Century Servs. Corp. v. Vista Inv. Advisors LLC, Opp. No. 123,203, 2002 WL 2022691, at *8 n.10 (T.T.A.B. Sept. 4, 2002). Where an applicant's use of the mark in question is limited, the Board has found that such applicant does not have the right to exclude others from use of its mark. Michael Stars, Inc. v. Michael Starr, Opp. No. 91164989, 2008 WL 3274130, at *12 (T.T.A.B. Aug. 1, 2008) (finding that any right of applicant to exclude others was extremely limited due to applicant's limited actual use of its mark as compared to opposer); In re Aladdin's Eatery, Inc., U.S. Ser. No. 76/020,517, 2006 WL 402558, at *6 (T.T.A.B. Feb. 7, 2006) (finding the right to exclude factor to be neutral where applicant's use was predominantly in a "circumscribed area" and where registrant had an earlier first use date).

Here, the limited nature of Applicant's use of the CITIAIR mark is determinative on this factor. Certainly with its modest annual sales and advertising expenses, compared to the enormous size and scope of Opposer's business under its CITI marks, Applicant has not developed any market strength. In addition, Applicant has provided on this record no evidence of any policing of its mark. Thus, this factor favors Citigroup.

M. Factor 12: Extent of Potential Confusion

In assessing the extent of potential confusion under the twelfth DuPont factor, the Board evaluates whether confusion is likely to be substantial or de minimis. In this connection, the Board has found this factor to weigh in favor of an opposer where the scope of the opposer's business is extensive, thereby reaching a large number of consumers who could potentially be confused. See William Carter Co. v. H.W. Carter & Sons, Inc., Opp. No. 91111355, 2004 WL 506139, at *16, *21, *24, *26 (T.T.A.B. Feb. 27, 2004) (holding twelfth DuPont factor weighed in favor of finding likelihood of confusion where the opposer sold millions of products annually and applicant marketed similar goods to similar purchasers). This is particularly true where the two parties' respective marks overlap in goods and services, or target markets. See Kenra, Inc. v. Belt Distribs., Inc., Can. No. 25,095, 2001 WL 1339414, at *10 (T.T.A.B. Oct. 24, 2001) (holding twelfth DuPont factor weighed in favor of finding likelihood of confusion where the parties both sold the same type of product, hair care products, to the same market, the ethnic hair care market).

As in Kenra, the parties here market comparable, if not identical, services using the same trade channels. (See Argument, Sections I.E-F, supra.) Moreover, the vast scope of Opposer's business means that an enormous number of customers could potentially be confused by Applicant's mark. As noted, Opposer's CITI-branded consumer credit card business alone has 22 million cardholders in North America, ***% of which are in the United States. (NOR Ex. 564, at OPP008482; see Villanueva Tr. at 28:7-17.) This factor would favor Opposer even if only the domestic NRI population was considered, as Opposer currently has ***** NRI customers nationwide. (See Citi Ex. 120.)

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* * *

In sum, an analysis of each of the DuPont factors shows that the Application poses a clear and serious risk of a likelihood of confusion to the CITI Marks. The decision on trademark confusion should thus be in favor of Opposer.

¹⁹ In addition, it is fair to assume that many members of the potential NRI market would have been exposed to (and/or utilize) Opposer's other financial services.

II.

THE PENDING APPLICATION IS LIKELY TO DILUTE OPPOSER'S MARKS

A. Applicable Standards

To establish likelihood of dilution by blurring under the Trademark Dilution Revision Act (the "Act"), Opposer must show that (i) Applicant uses its mark in commerce; (ii) Applicant adopted its mark after Opposer's marks became famous; (iii) Opposer's marks are famous and distinctive; and (iv) the Application is likely to dilute by blurring Opposer's CITI Marks. 15 U.S.C. § 1125(c)(1); see Citigroup Inc. v. Capital City Bank Grp., Inc., 94 U.S.P.Q.2d at 1665.

Here, not only does Opposer's evidence readily meet this standard, but it bears noting that this is precisely the type of scenario the Act is meant to address. The Act seeks to preclude relatively small third parties from gaining an advantage over their own direct competitors by leveraging a famous name. E.g., Nike, Inc. v. Maher, 100 U.S.P.Q.2d 1018, 1030 (T.T.A.B. 2011) (harm dilution does to a mark not only caused by third-party use or registration of an identical mark, but also by use of a mark that is "'close enough to the famous mark that consumers will recall the famous mark and be reminded of it . . . 'even if they do not believe that the goods come from the famous mark's owner,'" and that the ability of Opposer's mark to uniquely identify Opposer as a single source would be impaired by the third parties attempting to play off its mark (citation omitted)). Once one third party can take advantage of a famous mark, many others can avail themselves of this opportunity as well, leading to "'death by a thousand cuts.'" Nat'l Pork Bd. v. Supreme Lobster & Seafood Co., 96 U.S.P.Q.2d 1479, 1497 (T.T.A.B. 2010) (citation omitted).

This is the situation here. Applicant has identified several major direct competitors in his current market niche, and there can be no doubt that the association of its new service with the enormously famous CITI brand will give Applicant an immediate market advantage. At the same time, the usage will blur the distinctiveness of the CITI Marks, harm the strong association consumers have between such marks and the products and services offered by Opposer, and pave the way for others to take advantage of a similar opportunity.

B. Opposer's CITI Marks Meet the Dilution Fame Requirement

The level of fame required for dilution is more stringent than the level of fame required for likelihood of confusion. See Palm Bay Imps., 396 F.3d at 1374-75, 73 U.S.P.Q. 2d at 1694. Under the Act, a mark is famous when it is "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." 15 U.S.C. § 1125(c)(2). The Act enumerates four factors that a court may consider in making a determination of fame: (1) the duration, extent and geographic reach of advertising and publicity, whether by the owner or third parties; (2) the amount, volume and geographic extent of sales of goods/services offered under the mark; (3) the extent of actual recognition of the mark; and (4) whether the mark is registered. Id.

It is instructive to consider the many marks that have been recently found to be famous for purposes of establishing a likelihood of dilution. See, e.g., Nat'l Pork, 96 U.S.P.Q.2d at 1496 (dilution fame found with tracking studies showing public awareness of the mark at or above 80%); Jada Toys, Inc. v. Mattel, Inc., 518 F.3d 628, 635, 85 U.S.P.Q.2d 1895, 1900 (9th Cir. 2008) (holding that a reasonable trier of fact could find fame for the mark HOT WHEELS based on use of mark for 37 years, volume of sales, \$350 million in total promotional and advertising expenditures and international reach of sales); Hershey Co. v. Art Van Furniture, Inc., No. 08-14463, 2008 WL 4724756, at *13 (E.D. Mich. Oct. 24, 2008) (plaintiff's trade dress had established an iconic status); 7-Eleven Inc. v. Wechsler, 83 U.S.P.Q.2d 1715, 1722 (T.T.A.B. 2007) (finding fame for mark BIG GULP based on sales figures in excess of \$180 million per year from 1985 to 2001, millions of dollars spent on advertising, market research, and media evidence of widespread recognition of opposer's mark); Hormel Foods Corp. & Hormel Foods, LLC v. Spam Arrest, LLC, Can. No. 92042134, 2007 WL 4287254, at *17 (T.T.A.B. Nov. 21, 2007) (plaintiff's mark SPAM was famous for dilution purposes). Significantly, the TTAB itself recently found the CITIBANK family of marks to be famous for likelihood of dilution purposes. Citigroup Inc. v. City Bank Capital Grp., Inc., 94 U.S.P.Q.2d at 1658.

The CITI Marks undoubtedly meet this standard for dilution fame. As described in the Statement of Facts herein (Section D(2)), at any point over the past several decades, Opposer has owned several

dozen registered CITI Marks, as well as many unregistered marks incorporating the term CITI. As of December 31, 2011, Opposer's North America Regional Consumer Banking division included over 1,000 retail bank branches and 12.7 million customer accounts. In addition, Citigroup had 22 million credit card accounts in North America (not including its millions of co-brand credit card accounts). These totals do not include the recognition garnered for the CITI Marks by virtue of Opposer's thousands of ATM machines, in excess of ***** annual promotional mailings, huge commercial/government credit card businesses, and ***** worth of travel rewards redeemed annually. (See generally Statement of Facts, Sections D(4) & D(6), supra.)

Indeed, Opposer spends in excess of \$***** annually in advertising expenditures to promote the CITI brand, and has been supporting the brand with national advertising for decades. (See Statement of Facts, Section D(6)(c) supra.) Media coverage of, and references to, Opposer are extensive, including both unsolicited and solicited publicity in the forms of print media, television spots and parodies. (See id. at Section D(6)(d).)

Lastly, consumer research has confirmed that the CITI brand is widely recognized, and has been for well more than two decades. (See id. at Section D(6)(e).)

C. The Fame of the CITI Marks Pre-Dates Applicant's Use of the Applied-For Mark

Opposer's first federal registration for a "CITI"-prefixed mark (NOR Ex. 581) cited a date of first use of February 2, 1959. Court decisions have confirmed the fame of the CITI Marks as of at least as early as 1990. E.g., Citigroup Inc. v. City Holding Co., 171 F. Supp. 2d 333, 346, 351-52 (S.D.N.Y. 2001). The internal and external branding studies offered by Opposer date back to 1990. (Citi Exs. 98, 99, 101, 102.)

The pending Application recites a first use date of March 31, 2009 (NOR Ex. 566), which postdates the acquisition of fame by the CITI Marks by almost two decades.

D. The Applied-For Mark Is Likely To Dilute Opposer's CITI Marks

1. Legal Standards

The Lanham Act defines "dilution by blurring" as "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." 7-Eleven, 83 U.S.P.Q.2d at 1727 (citation omitted). In other words, in determining whether a mark is likely to cause dilution by blurring, the Board should consider whether target customers are likely to associate two different products or services with the mark even if they are not confused as to the different origins of these products or services. Toro Co. v. ToroHead Inc., 61 U.S.P.Q.2d 1164, 1184 (T.T.A.B. 2001) (noting that the dilution inquiry centers on whether "potential purchasers link the two marks in their minds even if it is simply to speculate as to why the other party should be able to use the famous mark of another").

In determining whether a mark is likely to cause dilution by blurring, the Board may consider "all relevant factors," including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark; (ii) The degree of inherent or acquired distinctiveness of the famous mark; (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark; (iv) The degree of recognition of the famous mark; (v) Whether the user of the mark or trade name intended to create an association with the famous mark; [and] (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B). As set forth below, an analysis of the factors enumerated by the Lanham Act provides ample evidence that consumers are likely to make an association between the Application and the CITI Marks, and that such Application is thus likely to dilute Opposer's marks.

2. Degree of Similarity Between the Marks

For the purposes of a dilution analysis, the marks at issue must be "sufficiently similar to trigger consumers to conjure up a famous mark when confronted with the second mark." Nike, Inc., 100 U.S.P.Q.2d at 1030 (finding sufficient similarity between JUST JESU IT and JUST DO IT). Thus, "substantial similarity," "identity," or "near identity" are not required for a finding of likelihood of dilution. Id. at 1029 (citing, inter alia, Levi Strauss & Co. v. Abercrombie & Fitch Trading Co., 633 F.3d 1158, 1171 (9th Cir. 2011)). In determining the similarity of the marks at issue, the TTAB uses "the

same test as for determining the similarity or dissimilarity of the marks in the likelihood of confusion analysis, that is, the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" Id. at 1030 (citation omitted).

As set forth above, it is clear that Applicant's mark and Opposer's family of CITI Marks are not only sufficiently similar for purposes of a likelihood of confusion analysis, they are strikingly similar. (See Argument, Section I(D), supra.) Applicant's word mark appropriates the term CITI, and merely adds a word and design descriptive of the services Applicant provides. See Augusta Nat'l, Inc. v. Nw. Mut. Life Ins. Co., 193 U.S.P.Q. 210, 222 (S.D. Ga. 1976) (LADIES' MASTERS AT MOSS CREEK PLANTATION likely to dilute MASTERS). Given the fame and broad scope of the CITI Marks, a third party usage (no less registration) of a CITI-prefixed mark such as Applicant's will certainly cause numerous consumers to think of Opposer and its famous family of marks. See Nike, Inc., 100 U.S.P.Q.2d at 1030; UMG Recordings, Inc. v. Mattel, Inc., 100 U.S.P.Q.2d 1868, 1886 (T.T.A.B. 2011).

3. Degree of Inherent or Acquired Distinctiveness of the Famous Mark

The Board has defined distinctiveness as a quality which causes the public to "associate the term with the owner of the famous mark even when it encounters the term apart from the owner's goods or services, i.e., devoid of its trademark context." Hormel Foods Corp., 2007 WL 4287254, at *17. In its decision in 7-Eleven, for instance, the Board found BIG GULP to be an inherently distinctive trademark because it was "suggestive" to consumers of something other than the dictionary meaning of the words themselves. 83 U.S.P.Q.2d at 1720-21; see also Nike, Inc., 100 U.S.P.Q.2d at 1028 (finding JUST DO IT mark to be distinctive because it was merely suggestive, and no other uses of the phrase by third parties had been revealed on the record).

The CITI Marks clearly enjoy a considerable degree of both inherent and acquired distinctiveness. Significantly, at least a dozen of Opposer's currently subsisting federal registrations for its CITI Marks have reached incontestable status (see NOR Exs. 577-583, 587, 588, 593, 599, 602), giving rise to a conclusive presumption that such marks are distinctive. See Nat'l Pork, 96 U.S.P.Q.2d at 1497 ("Even though inherent distinctiveness is not required, the statute is weighted toward a finding of

dilution when the famous mark in question is commercially-strong and inherently distinctive."); see also Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 205 (1985) (incontestability is sufficient basis for enjoining infringement).

Moreover, the CITI Marks are "suggestive, and not descriptive, because '[t]he term "Citi" does not describe a class of banking services or a characteristic of banking services.'" City Holding, 171 F. Supp. 2d at 346 (alteration in original) (citation omitted). Notably, the T.T.A.B. has previously found the CITIBANK mark to be suggestive, and inherently distinctive, and that this factor thus favored Opposer in an opposition proceeding relating to that mark. See Citigroup Inc. v. Capital City Bank Grp., Inc., 94 U.S.P.Q.2d at 1668.

Finally, testimony confirms that even if the CITI Marks were not already inherently distinctive, they certainly have acquired distinction, not only in the United States but also world-wide. (Moses Tr. at 43:2-25, 61:1-22.) This is not surprising. Not only does the sheer size and scope of Opposer's business suggest a great degree of acquired distinctiveness, but it should also be noted that Opposer's tens of millions of customers – as well as tens of millions of non-customers – are regularly and routinely exposed to Citigroup and its family of CITI Marks. Thus, Opposer sends at least ***** pieces of direct mail on an annual basis (Villanueva Tr. at 35:10-36:15), as only one part of its ***** of advertising expenditures in support of its CITI-branded services (Villanueva Tr. at 45:2-13).

Based on these facts, and on Applicant's failure to offer any evidence whatsoever of relevant third party uses of CITI Marks, such marks should be found to be distinctive for the purpose of a dilution analysis.

4. Substantially Exclusive Use of the CITI Marks

As shown above, Opposer has engaged in a comprehensive policing program. (E.g. Moses Tr. at 70:10-71:19, 80:6-81:12.) Applicant has failed to point to a single "CITI" federal registration, or even usage, in the travel area (or any other area) conducted by a third party. The evidence shows, moreover, that Opposer has enforced its CITI trademark rights in the travel space against third parties trying to use

CITI-based marks. (See Statement of Facts, Section D(3), supra.) This element, accordingly, is easily satisfied.

5. Degree of Recognition of the CITI Marks

The fourth dilution-by-blurring factor looks to the degree of recognition of the famous mark.²⁰ Courts have found that a mark enjoys a high degree of recognition for this purpose based on evidence of consumer awareness of the mark at issue, as well as the number of customers, locations and/or products. See Visa Int'l Serv. Ass'n v. JSL Corp., 590 F. Supp. 2d 1306, 1318 (D. Nev. 2008) (finding degree of recognition weighs in favor of dilution where surveys show customers are aware of the Visa brand), aff'd, 610 F.3d 1088 (9th Cir. 2010); Nike, Inc. v. Nikepal Int'l, Inc., 84 U.S.P.Q.2d 1820, 1828 (E.D. Cal. 2007) (finding degree of recognition weighs in favor of dilution where the NIKE mark is sold on millions of products and evidence demonstrates that the mark is readily recognizable). Moreover, the T.T.A.B. has held that once a mark is found to be famous for dilution purposes, it "must apply a sliding scale to determine the extent of that protection (i.e., the more famous the mark, the more likely there will be an association between the famous mark and the defendant's mark)." Citigroup Inc. v. Capital City Bank Grp., Inc., 94 U.S.P.Q.2d at 1668.

The CITI Marks no doubt have established a high degree of recognition -- as previously described herein (Statement of Facts, Section D(6), supra), the CITI Marks are among the most famous financial service trademarks in the world, have had brand awareness exceeding ***% for decades, and reach literally millions of domestic consumers.

6. Intended Association With Famous Mark

Applicant's founder has lived in the United States for a number of years, and before that in Singapore and India (Raj Tr. at 8:8-9:15), two countries where Opposer conducts significant business. (Nariman Tr. at 32:14-33:2, 36:21-37:1; Moses Tr. at 101:17-102:3; Citi Exs. 113-119; NOR Exs. 548-

²⁰ This factor has been considered superfluous by the Board, as it seemingly echoes the first factor in the likelihood of dilution analysis. See 7-Eleven, 83 U.S.P.Q.2d at 1729 (noting that "[t]his congressionally mandated factor seems redundant in view of the fact that opposer must establish that its mark is famous"); Citigroup Inc. v. Capital City Bank Grp., Inc., 94 U.S.P.Q.2d at 1668.

552.) One of the cities in India where Applicant has a bank account, in fact, is one where Opposer has a financial center. (Compare Raj Tr. at 66:22-68:8 with Citi Exs. 113 at 4, 119 at 2.) It is clear that Applicant is not unsophisticated as respects banking institutions – it has bank accounts with two banks in the United States (Bank of America and Citizens Bank) and allows the vast majority of its customers to pay for transactions using credit cards. (Raj Tr. at 40:13-16, 41:15-18, 42:19-43:9.) Despite these facts, Mr. Raj states that he was virtually unaware of the existence of either Citigroup or Citibank prior to this Opposition proceeding. (Raj Tr. at 24:16-25:11; NOR Ex. 605 at 47:2-20, 49:11-50:2, 62:19-63:4.)

As noted, Applicant contends that the term "Citi" was initially selected (in Singapore) as the prefix for its mark because it signifies "enlightenment" in the Tamil language. Yet it is not at all clear that a phonetic equivalent of the famous CITI mark (e.g. "City," "Sity," or "Siti") would not in the United States achieve the same purpose. It is notable, moreover, that no trademark search was ever conducted to determine the availability of the CITIAIR mark for Applicant's goods and services. (NOR Ex. 605, at 19:21-20:13.)

Thus, even if there is no direct proof of an actual intention on the part of Applicant to create an association with Opposer's famous CITI Marks, Applicant's denial of awareness of Opposer is difficult to accept, especially given that Applicant advertises its phone number as a "CITI" vanity telephone number. (Raj Tr. at NOR Ex. 605, at 37:3-19, 66:18-67:20.) This factor accordingly does not tip in Applicant's favor. See Nat'l Pork, 96 U.S.P.Q.2d at 1498.

7. Actual Association between Challenged Mark and Famous Mark

A showing of actual association is not necessary to succeed on a likelihood of dilution claim, see Nike, Inc., 100 U.S.P.Q.2d at 1031, and, as with actual confusion, it would be highly unlikely that such evidence would come to the attention of Opposer. This is particularly true given the short period of time in which the parties have coexisted, as well as Applicant's relatively limited use of its mark thus far. Cf. Nat'l Pork, 96 U.S.P.Q.2d at 1498 (as application was filed on an intent-to-use basis, there was no opportunity for actual association to have occurred).

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In sum, the extreme fame and distinctiveness of the CITI Marks, together with the fact that the parties offer closely related, if not identical, services using extremely similar marks, leave little doubt that Applicant's registration will blur the strong association made by purchasers between the CITI Marks and Opposer. For these reasons, the Application is likely to dilute Opposer's famous and distinctive CITI Marks, and should thus be refused registration on this basis as well. See Nike, Inc. 100 U.S.P.Q.2d at 1031 (finding a likelihood of dilution by blurring, despite no bad faith or actual association between the marks).

CONCLUSION

For all the foregoing reasons, Opposer respectfully requests that the Board sustain its Opposition to Applicant's pending application.

Dated: April 18, 2013

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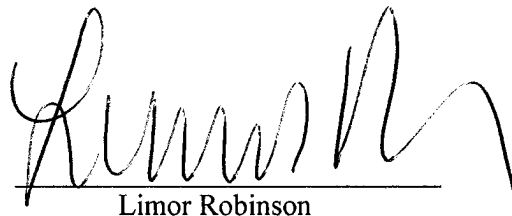
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CERTIFICATE OF SERVICE

I, Limor Robinson, a member of the bar of the State of New York, hereby certify that on this 18th day of April 2013, I caused a true and correct copy of the Post-Testimony Trial Brief of Opposer Citigroup Inc. to be served on the following person, BY MAIL AND EMAIL:

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